

2874

312.104331R00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: HILL et al.  
Serial No.: 09/342,707 ✓  
Filed: June 29, 1999 ✓



For: METHOD OF FABRICATING BRAGG GRATING USING  
A SILICA PHASE GRATING MASK AND MASK USED  
BY SAME

Group: 2874

Examiner: B. Healy

*Response  
w/ suppl.  
Shura  
3-9-00*

RESPONSE

Assistant Commissioner for Patents  
Washington, D.C. 20231

February 25, 2000

Sir:

In response to the Office Action dated December 17, 1999, enclosed please find a supplemental Reissue Application Declaration by the Assignee, signed by the authorized representative of the assignee on January 28, 2000.

In light of the submission of the supplemental declaration, reconsideration and removal of the objection to the original reissue declaration and the rejection of the claims under 35 USC 251 is respectfully requested. With regard to this, it is noted that the supplemental declaration being filed herewith overcomes each of the objections set forth in paragraph 1 on page 1 of the Office Action. Specifically, the supplemental declaration states the residence and post office address of the assignee, and also identifies each of the inventors. In addition, the declaration positively states that there are joint inventors. Accordingly, in light of the submission of this supplemental

declaration, reconsideration and removal of the objection to the declaration and the rejection of the claims is respectfully requested.

As noted in the amendment filed on December 23, 1999, a preliminary motion has been filed in Interference No. 104,331 requesting that the present reissue application be brought into that interference. As also noted in the December 23, 1999 amendment, claims 30-40 and 42 have been cancelled in the present reissue application to avoid dismissal of the preliminary motion. For the Examiner's information regarding this matter, enclosed is a copy of the Administrative Patent Judge's Order in the interference, dated December 29, 1999, indicating:

"In light of Party Hill's representation that the amendment to cancel new claims 30-40 and 42 in reissue application 09/342,707 is for the purpose of avoiding dismissal of its preliminary motions 4 and 8 in this interference, the amendment should not constitute a bar to Party Hill's reintroducing these claims into the reissue application subsequent to the termination of this interference."

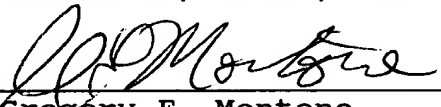
Accordingly, applicants respectfully reserve the right to reintroduce the cancelled claims after the termination of the interference, either in the present reissue application, a continuation reissue application or a subsequently filed reissue application.

If the Examiner believes that there are any other points which may be clarified or otherwise disposed of, either by telephone discussion or by personal interview, the Examiner is invited to contact applicants' undersigned attorney at the number indicated below.

To the extent necessary, the applicants petition for an extension of time under 37 CFR 1.136. Please charge any shortage in the fees due in connection with the filing of this paper, including extension of time fees, to the deposit account of Antonelli, Terry, Stout & Kraus, LLP, Deposit Account No. 01-2135 (312.104331R00), and please credit any excess fees to said deposit account.

Respectfully submitted,

ANTONELLI, TERRY, STOUT & KRAUS, LLP

✓   
\_\_\_\_\_  
Gregory E. Montone  
Registration No. 28,141

GEM/vlc  
(703) 312-6600

Attachments

## **CERTIFICATE OF SERVICE**

I hereby certify that the below-listed correspondence:

1. Response with Supplemental Reissue Application Declaration by Assignee and attachments

is being served on February 25, 2000, via Federal Express overnight delivery, as follows:

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By:   
Gregory E. Montone

Date: February 25, 2000

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Filed by: Jameson Lee  
Administrative Patent Judge  
Box Interference  
Washington, D.C. 20231  
Tel: 703-308-9797  
Fax: 703-305-0942

Paper No. 189

888-104331



UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES  
(Judge Jameson Lee)

mk/wis/  
Ser.

DANA Z. ANDERSON, TURAN ERDOGAN, and  
VICTOR MIZRAHI

MAILED

Junior Party,  
(Patent No. 5,327,515),

DEC 29 1999

v.

PAT. & T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

KENNETH O. HILL, BERNARD Y. MALO,  
FRANCOIS C. BILODEAU, and DERWYN C. JOHNSON

Junior Party  
(Patent No. 5,367,588)

v.

ELIAS SNITZER, and JOHN D. PROHASKA  
(Application 08/310,426)

Patent Interference No. 104,331

ORDER

Party Hill has filed a paper (Paper 188) entitled  
"Memorandum Regarding Telephone Conference," summarizing the

Interference No. 104,331  
Anderson v. Hill v. Snitzer

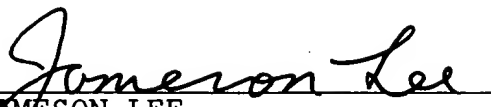
discussions in a telephone conference on December 17, 1999,  
between the administrative patent judge and counsel for  
respective parties.

In light of party Hill's representation that the amendment to cancel new claims 30-40 and 42 in reissue application 09/342,707 is for the purpose of avoiding dismissal of its preliminary motions 4 and 8 in this interference, the amendment should not constitute a bar to party Hill's re-introducing these claims into the reissue application subsequent to termination of this interference. However, if party Hill is not the prevailing party in this interference, then re-introducing these same claims or introducing any other claim into the reissue application will be subject to the examiner's own evaluation as to whether the claims define an invention separately patentable over the lost count. If they do not, then the claims will not be patentable to party Hill. See, In re Deckler, 977 F.2d 1449, 24 USPQ2d 1448 (Fed. Cir. 1992) (party losing interference is not entitled to claims to the same patentable invention as the count).

It is **ORDERED** that party Hill shall, upon termination of this interference, if it is the non-prevailing party as to the subject matter of any count, file a paper in its reissue application 09/342,707, directing the examiner's attention to

Interference No. 104,331  
Anderson v. Hill v. Snitzer

this communication and also furnishing a copy of this paper to  
the examiner.

  
JAMESON LEE  
Administrative Patent Judge

Date: 12/29/99  
Arlington, VA

Interference No. 104,331  
Anderson v. Hill v. Snitzer

By First Class Mail

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Addendum

Attachment 1

METHOD OF FABRICATING BRAGG GRATINGS USING A SILICA GLASS  
PHASE GRATING MASK AND MASK USED BY SAME

Attachment 2

The original patent failed to recite the relationship of the original patent with the parent applications of U.S. Patent Nos. 5,216,739 and 5,104,209 and failed to claim benefit thereof under 35 U.S.C. 120; and claim 15 of the original patent did not have proper antecedent basis for "the striations" so that claim 15 has been amended to depend from claim 10 rather than claim 8.

I hereby claim the benefit under Title 35, United States Code, Section 120 of any United States application(s) listed below:

<u>(Application Serial No.)</u>	<u>Filing Date</u>	<u>Status</u>
656,462	February 19, 1991	patented (5,104,209)
811,299	December 20, 1991	patented (5,216,739)